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TO: U. S. Patent and Trademark Office  
Attn: Examiner: Brian E. Pellegrino  
Art Unit: 3738

FAX NO.: (571) 273-8300

DATE: July 25, 2006

FROM: Thad Faleski

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CLIENT NO.: 1373-02207

TOTAL NUMBER OF PAGES (INCLUDING THIS ONE)

8

COMMENTS: Re: U.S. Patent Application No. 10/779,980  
Filing Date: February 17, 2004  
Applicant(s): Michael H. Heggeness

The following documents are attached for filing:

*Pre-Appeal Brief Request for Review (5 p.) Notice of Appeal (1 p.) (PTO Acct. charged \$250 sm. ent.) Pre-Appeal Brief Request for Review (1 p.)*

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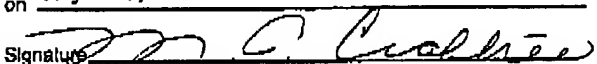

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 1373-02207 TF	
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		First Named Inventor Michael H. Heggeness	
		Art Unit 3738	Examiner Brian E. Pellegrino
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98) <input checked="" type="checkbox"/> attorney or agent of record. 36,962 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature MARCELLA D. WATKINS Typed or printed name (713) 238-8000 Telephone number July 25, 2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.9. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Michael H. Heggeness	§	ART UNIT: 3738
	§	
SERIAL NO.: 10/779,980	§	
	§	
FILED: February 17, 2004	§	EXAMINER: Brian E. Pellegrino
	§	
FOR: Bone Compression Devices and	§	
Systems and Methods of	§	CONFIRMATION NO. 1339
Contouring and Using Same	§	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Atty. Dkt. No.: 1373-02207

Date: July 25, 2006

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellant hereby submits this Pre-Appeal Brief Request for Review in connection with the above-identified application. A Notice of Appeal is filed concurrently herewith.

Appellant has received the final Office Action dated June 15, 2006, in which the Examiner: 1) rejected claims 28-35 and 37-39 under 35 U.S.C. § 102(b) believing them to be being anticipated by Coates et al. (U.S. Patent 5,423,826) (hereinafter *Coates*); and 2) rejected claims 28, 35, and 36 under 35 U.S.C. § 103(a) believing them to be unpatentable over Judet (U.S. Patent 4,263,904) (hereinafter *Judet*) in view of Rouse (U.S. Patent 2,002,021) (hereinafter *Rouse*).

Appellant respectfully submits that the final Office action dated June 15, 2006 contains omissions of one or more essential elements needed for a *prima facie* rejection. In particular, a common limitation in each rejected claim is not met by any reference cited by the Examiner.

Claims 28-39 are pending in this application. Claim 28 is an independent claim upon which claims 29-39 depend. In pertinent part, claim 28 reads as follows:

28. A bone compression system for placing in communication with at least one bone having at least one bone radius of curvature, the bone compression system comprising:  
a plate . . . ; and  
a tensioner for facilitating the movement of the plate from the pre-formed shape to the at least one elastic shape that substantially corresponds to at least one of the at least one bone radii of curvature, the tensioner including a shaft, a base, and at least two arms adapted to be

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releasably secured to the plate, the shaft having a shaft first end, a shaft second end, a shaft longitudinal axis, and at least one screw groove disposed along the shaft longitudinal axis to facilitate the movement of the at least two arms along the longitudinal axis of the shaft, the shaft second end being connected to the base, the base adapted to releasably engage the plate between the at least two arms so that engagement of said plate by said arms and said base enables the tensioner to alter the curvature of the plate.

Thus, the claimed tensioner includes: 1) a shaft having a shaft second end connected to a base; 2) at least two arms adapted to be releasably secured to the plate; and 3) the base adapted to releasably engage the plate between the at least two arms. Thus, at least three distinct components of the claimed tensioner are adapted to releasably engage the plate; namely the tensioner includes at least two arms adapted to be releasably secured to the plate AND a base on the second end of the shaft adapted to releasably engage the plate between the at least two arms. For example, the embodiment of tensioner 170 illustrated in Figure 11 (reproduced below) includes: 1) a shaft 180 having a shaft second end 182 connected to base 188; 2) a first arm 191 and a second arm 192 releasably secured to plate 50; and 3) the base 188 releasably engaging plate 50 between first arm 191 and second arm 192.

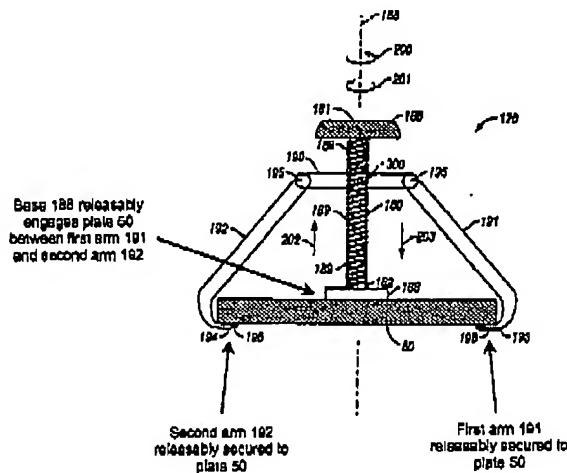


Figure 11

# **CLAIMS 28-25 AND 37-39 ARE NOT ANTICIPATED BY COATES**

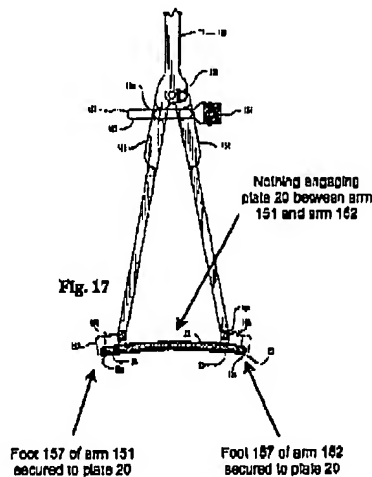
As previously argued on pages 6-8 of the Applicant's Response dated December 27, 2005, nothing in *Coates* teaches or discloses a base adapted to releasably engage the plate between at least two arms. *Coates* discloses a holder-drill guide 150 having two arms 151, 152, each having a foot 157 at one end. Col. 13, Lines 4-6; Figure 17 (reproduced below). Plate 20 is secured between the two feet 157. Figure 17. Thus, plate 20 is secured between arms 151, 152 solely by two feet 157.

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Figure 17. No other component(s) of guide 150 secures or engages plate 20. Since no part of guide 150 disclosed in *Coates* engages plate 20 between arms 151, 152, *Coates* cannot be said to teach or disclose a base adapted to releasably engage the plate between at least two arms as presently claimed.



*Coates* Figure 17

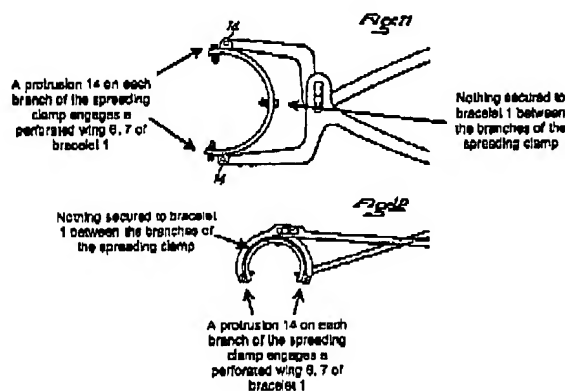
In response to Applicant's argument, the Examiner states "Applicant argues that the *Coates* device does not releasably engage the plate between the arms of the tool." The Examiner then goes on to state that "it is the Examiner's position that as seen in Fig. 17 the base portion 157 is on both arms and has a slot to receive the plate between the arms of the tool." Applicant acknowledges that *Coates* discloses a plate 20 releasably secured between arm 151 and arm 152 of guide 150. However, claim 28 recites a base adapted to releasably engage the plate between the at least two arms. This limitation is not satisfied by the mere fact that plate 20 of *Coates* is releasably secured between arms 151, 152. Rather, this limitation requires a base, distinct and separate from the at least two arms, that releasably engages the plate between the at least two arms. Guide 150 of *Coates* teaches two arms 151, 152, each including a foot 157 at an end which are employed to secure plate 20. Figure 17. However, *Coates* does not teach or disclose a third component, namely a base, that also releasably engages plate 20 between arms 151, 152. Therefore, Applicant submits that claim 28 is not anticipated by *Coates* because *Coates* fails to disclose each and every limitation of rejected claim 28. Dependent claims 29-39 must *a fortiori* also be allowable, as they carry with them all the limitations of the independent claim from which they depend.

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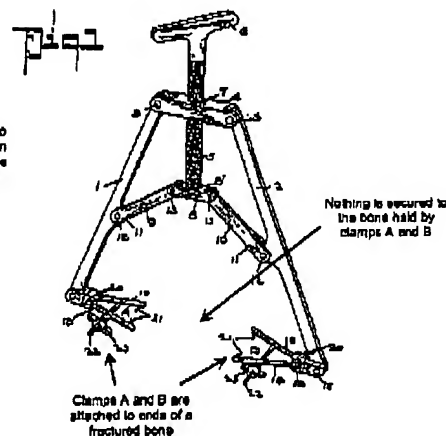
# **CLAIMS 28, 35, AND 36 ARE NOT OBVIOUS OVER *JUDET* IN VIEW OF *ROUSE***

In rejecting claims 28, 35, and 36 believing them to be obvious over *Judet* and *Rouse*, the Examiner relies on *Judet* to provide all the limitations of independent claim 28 with the exception of "a shaft with a screw groove . . ." However, as previously argued on pages 9-10 of the Applicant's Response dated December 27, 2005, nothing in *Judet* teaches or discloses a tensioner including a base adapted to releasably engage the plate between at least two arms. *Judet* discloses a spreading clamp that may be used to spread open bracelet 1 and place bracelet 1 around a bone. Col. 2, Line 66 to Col. 3, Line 3; Figures 11 and 12 (reproduced below). A protrusion 14 on each branch of the spreading clamp engages a perforated wing 6, 7 provided at each end of bracelet 1. Figure 11 and 12. However, no other component(s) of the spreading clamp disclosed by *Judet* attaches to or engages bracelet 1. Thus, *Judet* does not teach or disclose a base adapted to releasably engage the plate between the at least two arms.

These missing limitations cannot be provided by *Rouse*. *Rouse* discloses a surgical fracture extension appliance to adjust the fractured ends of a bone. Col. 1, Lines 1-7; Figure 1 (reproduced below). The appliance includes arms 1, 2 each having a clamp A, B, respectively, at one end.. Col. 2, Lines 9-13; Figure 1. Clamps A, B are rigidly attached to the ends of a fractured bone. Col. 2, lines 52-54; Figure 2. Thus, clamps A, B disclosed in *Rouse* attach to ends of a fractured bone. However, no other component(s) of the appliance disclosed in *Rouse* attaches to or engages a bone, a plate, or otherwise. Thus, *Rouse* does not teach or disclose a base adapted to releasably engage the plate between the at least two arms.



*Judet* Figures 11 and 12



*Rouse* Figure 1

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In final Office action dated June 15, 2006, the Examiner did not respond to these arguments. In addition, in the final Office action dated June 15, 2006, the Examiner states *Judet* discloses "a tensioner tool having a base and two arms adapted to be releasably secured to the plate." However, claim 28 recites a base adapted to releasably engage the plate between the at least two arms. The Examiner has not pointed to any structure, disclosure, or teaching in *Judet* or *Rouse* that satisfies this limitation of claim 28.

Applicants therefore respectfully submit that the Examiner has failed to demonstrate a *prima facie* case of obviousness in rejecting claims 28, 35, and 36, because the Examiner has failed to cite references that teach or suggest all of the elements recited in the rejected claims. Since independent claim 28 is submitted to be allowable, dependent claims 35 and 36 must *a fortiori* also be allowable, since they carry with them all the limitations of such independent claims.

#### CONCLUSION

For at least the reasons stated above, appellants respectfully submit that the rejections should be reversed. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Conley Rose, P.C. Deposit Account No. 03-2769.

Respectfully submitted,



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